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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/841,795 | 04/24/2001 | Jonathon J. Lipman | 70788 | 6804 |

22242 7590 08/22/2002

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EXAMINER

MCCROSKY, DAVID J

| | |
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| ART UNIT | PAPER NUMBER |
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3736

DATE MAILED: 08/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/841,795

Applicant(s)

LIPMAN, JONATHON J.

Examiner

David J. McCrosky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-20 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: Applicant improperly states in the first paragraph of the specification that the present application is a continuation-in-part of a provisional and PCT application; "now Pat. No. 6,248,079" should be added after the non-provisional application number. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11, 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how a dolorimeter can act as a patient communication device.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

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(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1-4, 6-8, 12-14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Iliff. The reference discloses a system and method that uses a computer or telephone network to communicate with the patient. See col. 4. Questions concerning pain, such as chest pain or head injuries, are asked. See cols. 38 and 39. The answers are processed and results are generated. See col. 35, ll. 53-67. Consultations are repeated at different times. See col. 38, ll. 1-7. A pain scale is implemented. See col. 54, ll. 13-20.

Claims 1, 11, 12 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by Nenov. The reference discloses a system and method for using a computer to obtain a Glasgow coma score. See abstract. A pain questionnaire is administered. See col. 1, ll. 44-57. Various types of pain stimulators are taught. See col. 10, ll. 6-29.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson et al in view of Iliff. Peterson et al teach a drug pump method having a mode where a patient answers questions. See abstract and col. 26, ll. 10-15. The reference further discloses administering pain medication from a patient controlled

analgesia controller. See col. 8, ll. 50-54. The reference does not teach administering the questionnaire at a series of time points. However, Iliff discloses a method that uses a computer or telephone network to communicate with the patient. See col. 4. Questions concerning pain, such as chest pain or head injuries, are asked. See cols. 38 and 39. The answers are processed and results are generated. See col. 35, ll. 53-67. Consultations are repeated at different times to monitor a patient over time. See col. 38, ll. 1-7. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Peterson et al with the method of repeating a question/answer session at different times, as taught by Iliff, to monitor a patient over time.

Claims 10, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iliff. Iliff discloses a system and method that uses a computer to communicate with the patient as recited for claim 1. The reference does not teach a PDA. It would have been an obvious matter of design choice to modify the computer of Iliff with a PDA since Applicant has not disclosed that using a PDA solves any stated problem or is for any particular purpose and it appears that the system would perform equally well with any data processor.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nenov. Nenov teaches a system and method as recited for claims 1, 11, 12 and 18. The reference does not teach a dolorimeter utilizing a sonar ranging sensor. It would have been an obvious matter of design choice to modify the system and method of Nenov by using a sonar ranging sensor since Applicant has not disclosed that using such sensor

solves any stated problem or is for any particular purpose and it appears that the system/method would perform equally well with any type of pain stimulator.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Iliff. Iliff discloses a system and method that uses a computer or telephone network to communicate with the patient. See col. 4. Questions concerning pain, such as chest pain or head injuries, are asked. See cols. 38 and 39. The answers are processed and results are generated. See col. 35, ll. 53-67. Consultations are repeated at different times. See col. 38, ll. 1-7. A pain scale is implemented. See col. 54, ll. 13-20. The reference does not teach a hand-held device having a touch screen. It would have been an obvious matter of design choice to modify the computer of Iliff with a PDA since Applicant has not disclosed that using a PDA solves any stated problem or is for any particular purpose and it appears that the system would perform equally well with any data processor.

Allowable Subject Matter

Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Mcewen et al teach an apparatus and method for relating pain and activity of a patient. Maurer et al teach an electronic pain feedback system.

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Gaston-Johansson discloses a system and method for pain measurement and recording.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. McCrosky whose telephone number is 703-305-1331. The examiner can normally be reached on Mon-Fri 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric F. Winakur can be reached on 703-308-3940. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

DJM
August 19, 2002



ERIC F. WINAKUR
PRIMARY EXAMINER